Paper 20

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DANIEL L. **FLAMM**
Junior Party
(U.S. Application 08/748,746),

v.

GEORGY **VINOGRADOV** AND SHIMAO YONEYAMA
Senior Party,
(U.S. Patent 5,965,034).

Patent Interference No. 104,807

Before: TORCZON, TIERNEY and NAGUMO, Administrative Patent Judges.

TIERNEY, Administrative Patent Judge.

FINAL JUDGMENT

This interference was declared between Flamm U.S. Application No. 08/748,746 ("Flamm '746") and Vinogradov et al., U.S. Patent No. 5,965,034 ("Vinogradov '034"). At the time of declaration, the Flamm '746 application listed Daniel L. Flamm as sole inventor whereas Vinogradov '034 listed Georgy Vinogradov and Shimao Yoneyama as joint inventors. Both the Flamm application and the Vinogradov patent claim 35 U.S.C. §120 benefit of U.S. Application

No. 08/739,037, which lists Flamm, Vinogradov and Yoneyama as co-inventors.

Generally, the parties have agreed to settle the interference. As explained in the letter to APJ Tierney dated September 12, 2002, there was a contract and licensing dispute between Flamm and MC Electronics ("MCE"). (Paper No. 19, letter of September 12, 2002). Due to the dispute, there was a significant period of time where the parties had absolutely no communication. During that time, Flamm filed the Flamm '746 application and MCE filed the application that led to the Vinogradov '034 patent. Communication has now resumed between Flamm and KEM, the successor-in-interest to the intellectual property assets of MCE. As a result of the communications, the parties have discovered that Flamm, Vinogradov and Yoneyama each were co-inventors for the subject matter of both the Flamm application and the Vinogradov patent. The parties have now agreed to correct the inventorship of the involved Flamm application and Vinogradov patent.

In an effort to conclude the interference, the parties have jointly filed several unopposed motions. Specifically, the parties have filed: 1) a preliminary motion requesting that the inventorship of the Flamm application be corrected (Preliminary Motion 1, Paper No. 17); 2) a preliminary motion requesting that the inventorship of the Vinogradov patent be corrected (Preliminary Motion 2, Paper No. 18); and 3) a miscellaneous motion that requests entry of the following papers:

i. Power of Attorney granting Roger S. Borovoy and Hans R. Troesch power to act in the involved Flamm '746 application;
ii. Terminal Disclaimer in the involved '746 application;
iii. Assignment to assign an undivided joint interest in the '034 patent to Flamm;
iv. Assignment to assign an undivided joint interest in the '034 patent to Flamm;
v. Letter explaining the parties' proposed resolution of the issues in the interference.

Upon entry of the parties papers and motions, Flamm, Vinogradov and Yoneyama would be the named inventors for both the Flamm application and the Vinogradov patent.

Flamm, Vinogradov and Yoneyama have filed a declaration stating that they are the actual inventors of the '746 application, filed on November 18, 1996. (Preliminary Motion 1, Paper No. 17, Declaration under §1.63). Vinogradov and Yoneyama both testify that the error in failing to include their names on the '746 application occurred as a result of a complete breakdown in communication between KEM and Flamm due to a dispute over contractual and licensing issues. To the best of Vinogradov and Yoneyama's knowledge, Flamm was unaware that they were coinventors of the '746 application. Similarly, Flamm declares that the inventorship error in failing to include his name on the '034 patent was also due to the breakdown in communication between him and the assignee of the '034 patent. Flamm testifies that he had no knowledge of the application leading to the '034 patent and could not have suggested that he be added as an inventor. (Preliminary Motion 2, Paper No. 18, Statement of Non-Deceptive Intent). Both Vinogradov and Yoneyama agree to add Flamm as an inventor to the '034 patent.

We credit the testimony of Flamm, Vinogradov and Yoneyama. Based on the evidence of record, we conclude that Flamm, Vinogradov and Yoneyama are co-inventors of Flamm '746 and Vinogradov '034 and ***grant*** Preliminary Motions 1 and 2 (requests to correct inventorship). Additionally, the Miscellaneous Motion under 37 C.F.R. §1.635 (Paper No. 19) requests entry of certain papers into the interference file. This miscellaneous motion is also **granted** and a copy of the Power of Attorney and Terminal Disclaimer for the '746 application have been entered into

the '746 application file.

As the parties have agreed that the inventorship of the Flamm application and the Vinogradov patent are one and the same, and have submitted sufficient evidence demonstrating that the inventorship is the same, we conclude that the invention was not made by "such other inventor" or by "another inventor."[1] Accordingly, we terminate this interference and remand the involved Flamm '746 application and Vinogradov '034 patent to the examiner for further consideration. The examiner shall review the papers listed above to ensure that the inventorship changes are in technical compliance with USPTO procedures, and if not, provide an opportunity for correction.

Upon consideration of the record, it is:

ORDERED that the interference is terminated.

FURTHER ORDERED that Motion 1 to correct inventorship of Flamm U.S. Application No. 08/748,746 is ***granted***.

FURTHER ORDERED that Motion 2 to correct inventorship of Vinogradov et al., U.S.

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[1] 35 U.S.C. §102(g) is set forth below:

> (g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

(Emphasis added).

Patent No. 5,965,034 is ***granted***.

FURTHER ORDERED that Miscellaneous Motion under 37 C.F.R. §1.635 for entry of papers into the interference file is ***granted***.

FURTHER ORDERED that the Power of Attorney and Terminal Disclaimer for the '746 application be entered into the '746 application file

FURTHER ORDERED that Flamm U.S. Application No. 08/748,746 and Vinogradov et al., U.S. Patent No. 5,965,034 be returned to Technology Center 1700 for consideration of the procedural requirements for a change in inventorship.

FURTHER ORDERED that a copy of this final decision shall be placed and given a paper number in the file of Flamm U.S. Application No. 08/748,746 and Vinogradov et al., U.S. Patent No. 5,965,034.

FURTHER ORDERED that for any settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

RICHARD TORCZON)
Administrative Patent Judge)
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MICHAEL P. TIERNEY) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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cc (via Facsimile and First Class Mail)

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